

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of species III, Figure 4, claims 31-34, 41-43, 45, 46, 51 and 54-56, in the reply filed on 01/28/2008 is acknowledged.
2. It should be noted that claims 42-43 are not readable on the elected species because the sealing ring (50) in claim 42 is depicted not in Fig. 4 of the elected species but rather in Fig.3 of species II.
3. Claims 35-40, 42-44, 47-53 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 01/28/2008.

### *Drawings*

4. The drawings are objected to because labeling of Fig. 4 and numeral characters 44 and 12e are missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 31, 34, 41 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Tani et al (6,409,402).

The Tani et al reference discloses a cosmetic pencil comprising a sleeve body (2) which in its interior has a longitudinally extending cavity (22) which is open outwardly by way of at least one opening and a lead (M) of a cosmetic material, which is arranged in the cavity (22), wherein the lead (M) is arranged in the sleeve body (2) at least portion-wise in spaced relationship in the peripheral and/or longitudinal direction with respect to the inside wall of the cavity (22) of the sleeve body (2), forming an empty space, and wherein there is also provided a fixing securing means (23) for the lead (M) in the cavity (22) of the sleeve body (2), which fixes the lead (M) in the interior of the cavity (22) at least to prevent rotation thereof, a plurality of guide ribs (25) which extend in the longitudinal direction of the cavity (22) and which are arranged in mutually spaced

relationship in the peripheral direction thereof (Fig. 6a) and which are in line contact at least portion-wise with the outside surface of the lead (M) and that the sleeve body (2) is made from a transparent material.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 31-34, 41, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm (GB 1308074) in view of Tani et al.

The Dahm reference discloses a cosmetic marking instrument comprising a sleeve body (2) which in its interior has a longitudinally extending cavity which is open outwardly by way of at least one opening and a lead (5) of a cosmetic material, which is arranged in the cavity, wherein the lead (5) is arranged in the sleeve body (2) at least portion-wise in spaced relationship in the peripheral and/or longitudinal direction with respect to the inside wall of the cavity of the sleeve body (2), forming an empty space, and wherein there is also provided a fixing securing means (4) for the lead (5) in the cavity of the sleeve body (2), which fixes the lead (5) in the interior of the cavity at least to prevent rotation thereof, a plurality of guide ribs 6 which extend in the longitudinal direction of the cavity and which are arranged in mutually spaced relationship in the peripheral direction thereof and which are in line contact at least portion-wise with the outside surface of the lead (5).

Although Dahm does not disclose the sleeve body (2) made from a transparent material, attention is directed to Tani which teaches a cosmetic pencil having a body made from a transparent material.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Dahm device with a sleeve made of a transparent material as taught by Tani for a user to view the color and content of the cosmetic.

9. Claims 31-34, 41, 45, 46 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russ et al (4,383,875) in view of Tani et al.

The Russ et al reference discloses a cosmetic marking instrument comprising a sleeve body (10,10') which in its interior has a longitudinally extending cavity which is open outwardly by way of at least one opening and a lead (14) of a cosmetic material, which is arranged in the cavity, wherein the lead (14) is arranged in the sleeve body (10,10') at least portion-wise in spaced relationship in the peripheral and/or longitudinal direction with respect to the inside wall of the cavity of the sleeve body (10,10'), forming an empty space, and wherein there is also provided a fixing securing means (adhesive) for the lead (5) in the cavity of the sleeve body (10,10'), which fixes the lead (14) in the interior of the cavity at least to prevent rotation thereof, a plurality of guide ribs (12) which extend in the longitudinal direction of the cavity and which are arranged in mutually spaced relationship in the peripheral direction thereof and which are in line contact at least portion-wise with the outside surface of the lead (14), a cap (18).

Although Russ does not disclose the sleeve body (10,10') made from a transparent material, attention is directed to Tani which teaches a cosmetic pencil having a body made from a transparent material.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Russ device with a sleeve made of a transparent material as taught by Tani for a user to view the color and content of the cosmetic.

Regarding claims 46 and 54, the process of producing a cosmetic pencil would be inherently performed during the manufacturing of Russ modified cosmetic pencil.

10. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russ et al in view of Tani et al as described above and further in view of Berry (2004/0175223).

Although Russ does not teach a friction-reducing means applied to the outside of the lead, attention is directed to Berry which teaches a lead coated with a talc powder as a friction-reducing means (see paragraph 0039).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a coating of talc powder on the outside of the Russ lead as taught by Berry as a friction-reducing means.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 571-272-4890. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Huyen Le/  
Primary Examiner  
Art Unit 3751

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